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| 09/940,174 | 08/27/2001 | Lane W. Lee | M-12038 US | 5308 |
| 7590 05/29/2008 MACPHERSON KWOK CHEN & HEID LLP 1762 TECHNOLOGY DRIVE SUITE 226 SAN JOSE, CA 95110 | | | | |
| EXAMINER AUGUSTIN, EVENS J | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/940,174
Filing Date: August 27, 2001
Appellant(s): LEE ET AL.

Jonathan W. Hallman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/12/2008 appealing from the Office action mailed 12/08/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------|------------|---------|
| 6782190 | Morito | 9-1999 |
| 6519700 | Ram et al. | 10-1998 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 15, 17, 18 and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Morito, U.S. Patent No. 6,782,190.

As per claims 1, 2, 15, 17, 18, 21 and 22, Morito teaches a method and system for detecting unauthorized actions with respect to content on an optical disk comprising:

- A. reading an identifier on an optical disk (column 4, lines 20-65; column/line 5/63-6/3)
- B. determining whether the identifier was located in the read-only (i.e. Sp) or writeable portion (i.e. Sd) of the media disk (column/line 5/63-6/3)
- C. determining whether the identifier is pre-recorded (column 6, lines 8-11) or written (column 5, lines 60-64; column 6, lines 3-7) and if the identifier is pre-recorded (figures 1 and 2) and in the writeable portion (i.e. comparison step) then detecting an unauthorized action (i.e. detecting that the identifier from the ROM area Sp is different from the identifier Sd in the copy control information of the

writeable area) using only the identifier in the writeable portion (column/line 5/64-6/5; column 6, lines 12-15)

- D. reading the identifier during an optical disk [access] operation including one or more of record, play, get play key, copy, open, close or create (abstract; column/line 7/64-8/21)

As per claim 21, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. Hence, as Morito clearly discloses a structure comprising Applicant's reading means (column 4, lines 20-65; column/line 5/63-6/3), determining means (column/line 5/60-6/11) and detecting means (column 6, lines 12-15), Applicant's claim 21 is anticipated by the prior art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morito, U.S. Patent No. 6,782,190 in view of Ram et al., U.S. Patent No. 6,519,700.

As per claim 3, Morito discloses content copy protection (abstract). Specifically, Morito teaches detecting unauthorized copying of content from one optical disk to another. However, Morito does not explicitly recite revoking rights to content. Ram et al. teach revoking a user's access to content after detecting unauthorized use (column 8, lines 20-23). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Morito and Ram et al. in order to extend the copy protection scheme of Morito. For example, by implementing the Morito system with additional rights directed to the content itself ('700, column 8, lines 1-22), content "ripped" from the optical disk cannot be redistributed without authorization from the content owner.

7. Claims 9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morito, U.S. Patent No. 6,782,190.

As per claims 9 and 21, Morito teaches reading an identifier on a media disk (column 4, lines 20-65; column/line 5/63-6/3). Claims 9 and 21 are dedicated to a description of the identifier. However, this is non-functional data as the method and apparatus do not perform key generation and using a generated key to decrypt files. Recall claims 1 and 15, from which claims 9 and 21 depend, respectively, are dedicated to detecting unauthorized actions. The MPEP defines non-functional descriptive material as data that does not alter the performance of a process or computer (2106 section V, B, 2). Therefore, to one of ordinary skill once said unauthorized action is identified no further processing or access is permitted (for example see claim 3) (descriptive material cannot render non-obvious an invention that would have otherwise been obvious (*In re*

Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

(10) Response to Argument

Argument 1: A conditional claim limitation in claim 1 has been, given no weight

Response 1: Examiner does not agree with the notion that conditional claim limitation is given no weight.

With regard to the limitations of claim 1, they anticipated by cited reference of Morito (U.S. 6782190) as followed:

| Limitation # | <u>Claim 1</u> | <u>6,782,190</u> |
|---------------------|--|---|
| 1 | reading an identifier on the optical disk | Reading disk identifier (C5, L13, L60) |
| 2 | determining whether the identifier was located in the read-only or the writeable portion of the media disk | Determining that the identifier is located in the read only area (C4, L22-24, L57-58) |
| 3 | determining whether the identifier identifies itself as a pre-recorded identifier or as a written identifier | the manufacturer produces a blank disk which includes, for example, a unique serial number in the identification area 2. The data area 3 is however available to be written to, once only, by the content provider, using conventional data writing apparatus |
| 4 | if the identifier identifies itself as a pre-recorded identifier and is located in the writeable portion of the optical disk, detecting an unauthorized action, solely from the pre-recorded identifier being located in the writeable portion | Disk identifier being used detect unauthorized action such unauthorized copies (C6, L3-14, L15-27) |

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Evens J. Augustin

Evens J. Augustin

Examiner, Art Unit 3621

May 26, 2008

Conferees:

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